

REMARKS/ARGUMENTS

Claims 237-299 are pending. Applicant respectfully submits that no new matter has been added by way of this amendment. Support for the amendments to the claims can be found throughout the specification and claims as originally filed. Particular examples of support are provided in the following table.

Claim	Illustrative Support
237	Page 25, line 25 – page 26, line 7; page 31, lines 10–14; page 41, lines 13–16; page 42, line 10 – page 43, line 13; page 47, lines 19–25; page 42, line 10 – page 43, line 13; page 155, line 5 – page 156, line 19; Examples I.A, I.B1-B3, I.C1-C3, I.D1-D3, I.F1-F3, I.G1-G3; Example II; and Example III.
241	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
246	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
248	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
254	Page 20, line 16 – page 21, line 8; page 25, lines 25–27; page 31, lines 10–14; page 155, line 5 – page 156, line 19; Examples I.A, I.B1-B3, I.C1-C3, I.D1-D3, I.F1-F3 and I.G1-G3.
263	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
273	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
279	Page 24, line 7 – page 25, line 6; the Examples; and the claims as originally filed.
291	Page 40, line 15 – page 46, line 15.
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299	Page 40, line 15 – page 46, line 15.

Applicant hereby incorporates all previous responses by reference in entirety.

I. THE REJECTION UNDER 35 U.S.C. § 112 SHOULD BE WITHDRAWN.

The Office Action rejected claims 237-280 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully requests that this rejection be withdrawn in light of the current amendments, made without admitting or conceding in any manner that the rejected claims fail to comply with 35 U.S.C. § 112, first paragraph and solely to expedite the prosecution of the present application.

According to the M.P.E.P., the scope of enablement must only bear a “reasonable correlation” to the scope of the claims. M.P.E.P. § 2164.08 (citing *In re Fisher*, 427 F.2d 833

(C.C.P.A. 1970)). Applicant submits that the specification provides a scope of enablement reasonably correlated to the scope of the currently amended claims. *See In re Wands*, 858 F.2d at 737, 8 U.S.P.Q. 2d at 1404; M.P.E.P. § 2164.06.

In addition, the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 U.S.P.Q. 642, 645 (C.C.P.A. 1970); M.P.E.P. § 2164.02. Compliance with the enablement requirement does not turn on whether an example, working or prophetic is disclosed. M.P.E.P. § 2164.02. Further, detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to practice the invention. M.P.E.P. § 2164. Since only an enabling disclosure is required, applicant need not describe all actual embodiments. M.P.E.P. § 2164.02.

Applicant respectfully traverses the Office Action's statement that "[t]here is no evidence in the record that a composition meeting the ratio requirement without using bicarbonate as the buffering agent or meeting the range requirement." Applicant submits that the claims as amended are fully enabled and cites several examples for the buffering agents identified in the currently amended claims. Specifically, Examples I.B2, I.C2, I.D2, I.F2 and I.G2 all recite combinations of omeprazole with buffering agents other than sodium bicarbonate that fall within the limitations of the claims as amended. Below is a table that provides the weight percent ("wt-%") and amounts of buffer and disintegrant for Examples I.B2, I.C2, I.D2, I.F2 and I.G2.

Disintegrant and Buffer Ranges for Formulations Without Sodium Bicarbonate					
Example	Weight (mg)	Disintegrant (mg)	Disintegrant (wt-%)	Buffer (mg)	Buffer (wt-%)
I.B2	892.5	12	1.3%	750	84%
I.C2	902.5	12	1.3%	750	83%
I.D2	682	12	1.8%	650	95%
I.F2	790	12	1.5%	725	92%
I.G2	825	12	1.5%	800	97%

Furthermore, to the extent that the Office Action dated February 1, 2008 suggests that the ranges lack support in the specification, Applicant respectfully traverses this contention. As indicated above and in Applicant's response dated October 31, 2007, the examples and specification provide support for the claims. It is entirely appropriate to look to examples in the specification as support for the claims. *See Capon v. Eshhar*, 418 F.3d 1349, 1360-61 (Fed. Cir.

2005); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1566-68, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). In addition, “ranges found in applicant’s claims need not correspond exactly to those disclosed in a parent application; the issue is whether one skilled in the art could derive the claimed ranges from the parent’s disclosure.” *Vas-Cath Inc.*, 935 F.2d at 1566, 19 U.S.P.Q.2d 1111. As discussed above, additional support for the claimed ranges can be found throughout the specification and examples as filed.

Therefore, Applicant respectfully submits that the rejection under 35 U.S.C. § 112 should be withdrawn.

II. THE REJECTION UNDER 35 U.S.C. §§ 102(f) AND (g) SHOULD BE WITHDRAWN.

The Office Action rejected claims 237-280 under 35 U.S.C. §§ 102(f) and (g) as being anticipated by Hall *et al.* US2005/0037070 or Olmstead *et al.* US2005/0266071.

Applicant respectfully traverses the characterization of these applications as prior art. This instant application is a continuation of U.S. patent application Ser. No. 10/722,184, filed on Nov. 25, 2003, which is a continuation of U.S. patent application Ser. No. 10/054,350, filed on Jan. 19, 2002, now U.S. Pat. No. 6,699,885, which is a continuation-in-part of U.S. patent application Ser. No. 09/901,942, filed on Jul. 9, 2001, now U.S. Pat. No. 6,645,988, which is a continuation-in-part of U.S. patent application Ser. No. 09/481,207, filed on Jan. 11, 2000, now U.S. Pat. No. 6,489,346, which is a continuation-in-part of U.S. patent application Ser. No. 09/183,422, filed on Oct. 30, 1998, now abandoned, which is a continuation-in-part of U.S. patent application Ser. No. 08/680,376, filed on Jul. 15, 1996, now U.S. Pat. No. 5,840,737, which claims priority to U.S. Provisional Application Ser. No. 60/009,608, filed on Jan. 4, 1996.

This application claims priority through its related applications before the date of publication and the filing dates of both Hall *et al.* US2005/0037070 or Olmstead *et al.* US2005/0266071. As discussed above, support for the claimed ranges can be found throughout the specification and examples as filed. The specification of the present application is the same as the specification of U.S. patent application Ser. No. 10/722,184, filed on Nov. 25, 2003 and U.S. patent application Ser. No. 10/054,350, filed on Jan. 19, 2002. No new matter has been presented by way of any amendments to the claims, and the cited applications are not prior art to the pending claims. Applicant respectfully requests that this rejection be withdrawn in light of the current amendments, made without admitting or conceding in any manner that the rejected

claims fail to comply with 35 U.S.C. § 102 and solely to expedite the prosecution of the present application. Therefore, Applicant respectfully submits that the rejection under 35 U.S.C. §§ 102(f) and (g) should be withdrawn.

III. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING

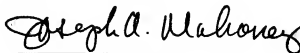
Claims 237-280 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over various claims of U.S. 6,489,364, U.S. 6,489,364 in view of Jung et al. CA 128:261816, U.S. 6,699,885 or copending application SN 10/641,732 as described in the Office Action. Applicant assumes that the Office Action was referring to U.S. 6,489,346 instead of U.S. 6,489,364, and will submit a terminal disclaimer once allowable subject matter is indicated.

Conclusion

For at least the foregoing reasons, it is respectfully submitted that claims 237-299 are in condition for allowance. Early and favorable consideration is respectfully requested, and the Examiner is encouraged to contact the undersigned with any questions or to otherwise expedite prosecution. Further, none of Applicant's amendments or cancellations are to be construed as dedicating any such subject matter to the public, and Applicant reserves all rights to pursue any such subject matter in this or a related patent application.

Kindly contact the undersigned with any questions or to otherwise expedite prosecution.

Respectfully submitted,



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